

REMARKS

Claims 1 and 3-11 are pending and stand ready for further action on the merits.

Support for the amendment to claim 1 can be found in claim 3. Support for new claim 10 can be found on page 14, lines 1-14. Support for new claim 11 can be found in the paragraph bridging pages 11-12.

The specification has been amended to remove typographical/grammatical error(s).

No new matter has been added by way of the above-amendment.

Status of Claims 6-9

The Examiner notes in the paragraph numbered as "1", on page 2 of the outstanding Office Action, that the Notice of Allowance mailed May 5, 2003 has been vacated. Accordingly, the Examiner's Amendment, wherein claims 6-9 were cancelled, has been rendered moot. Thus, claims 6-9 remain withdrawn from consideration as being drawn to non-elected subject matter.

The Examiner will note that claims 6-9 have been identified as being "withdrawn" in the above set of claims.

Issues Under 35 USC § 103

Claims 1-5 stand rejected under 35 USC § 103(a) as being unpatentable over Tsuto et al. (EP 1061120) in view of Perry's

Chemical Engineers' Handbook (hereinafter "CEH '97"). Applicants respectfully traverse the rejection.

According to MPEP § 2143.03, a *prima facie* case of obviousness cannot be said to exist unless the cited references teach or fairly suggest all of the limitations in the inventive claims. Applicants respectfully submit that a *prima facie* case of obviousness does not exist over Tsuto et al., either alone or in combination with CEH '97, since these references fail to teach or fairly suggest a method for preparing a fatty acid ester comprising a step of recycling a reaction mixture containing un-reacted reactants and/or intermediate products to the reactor, wherein the monohydric alcohol and the fatty acid ester are removed from the reaction mixture prior to being recycled into the reactor.

The Examiner appears to be aware that Tsuto et al. do not exemplify the inventive recycling step. However, the Examiner has taken the position that despite this deficiency, Tsuto et al., either alone or in combination with CEH '97, fairly suggest this recycling step.

Applicants respectfully disagree.

First, the Examiner points to column 3, lines 40-45 of Tsuto et al. for teaching that there are economic benefits of using spent oils to promote recycling of the resource. See page 3, last paragraph of the outstanding Office Action. Applicants respectfully submit that the skilled artisan would understand that this section

of Tsuto et al. refers to the use of waste from household sources. This section does not imply the recycling of unreacted reactants and/or intermediate products as described in the inventive claims.

Also, the Examiner points to column 6, lines 1-15 of Tsuto et al. for teaching the inventive recycling step. Applicants respectfully submit that this section of Tsuto et al. refers to the removal of glycerin (column 6, lines 3-4) and alcohol (column 6, lines 7-8) from the final product fatty acid ester in a **purification** step. There is no teaching or suggestion by Tsuto et al. to remove un-reacted reactants and/or intermediate products for recycling into the reactor.

Furthermore, Applicants respectfully submit that the skilled artisan would not be motivated to remove the monohydric alcohol from the reaction mixture prior to the reaction mixture being recycled back the reactor. Based on the Examiner's logic, the monohydric alcohol would necessarily be required to be recycled back to the reactor, since the Examiner's position is that the motivation for the skilled artisan to modify the teachings of Tsuto et al. is to recycle unreacted material. Clearly, at least a portion of the monohydric alcohol in the exit stream from the reactor would be un-reacted starting materials.

Lastly, Applicants note that the Examiner cites CEH '97 for describing that "all reactor modes can sometimes be advantageously

operated with recycling of part of the product or intermediate streams."

Applicants respectfully submit that this passage fails to cure the deficiencies of Tsuto et al., since this passage describes common recycling of the product or intermediate streams but does not describe the recycling of the reaction product which is obtained by reacting fats and oils with a monohydric alcohol under conditions where the monohydric alcohol is in a supercritical state. Also, this passage does not cure the deficiency of Tsuto et al. by describing a step of removing the monohydric alcohol from the reaction mixture prior to being recycled into the reactor.

Based on the foregoing, Applicants respectfully submit that a *prima facie* case of obviousness cannot be said to exist since all of the claimed elements are neither taught nor fairly suggested by Tsuto et al. and CEH '97, and as such, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of three (3) months

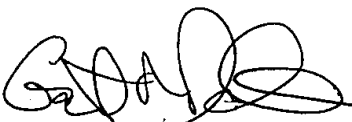
to May 19, 2004, in which to file a reply to the Office Action. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2448 for the required fee of \$950.00.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 
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